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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/088,059

05/29/2002

Frank Naumann

H 3939 PCT/US

6726

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7590

03/31/2005

HENKEL CORPORATION
THE TRIAD, SUITE 200
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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,059	NAUMANN ET AL.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 21-23 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-23 and 25-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 11/24/04, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims pending are 19, 21-23 and 25-38.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

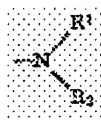
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

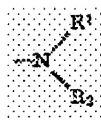
4. Claims 19, 21-23, 25, 26, 28-30, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Bil (US 3,632,582), of record.

Bil teaches nitro-p-phenylenediamine compounds suitable as hair dyes. See col.

- 2-3. Specifically, Bil teaches the compounds of the following formula:

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wherein Y and Z might be , in which R_1 and R_2 might be identical or different and represent, inter alia, H and cycloalkyl radicals. See col. 2, lines 20-41. When R_1 and/or R_2 is cycloalkyl, it usually contains 5 or 6 carbon atoms. See col. 3, lines 46-47. Further, Bil exemplifies N-cyclohexyl-2-nitro-p-phenylenediamine compound in which one of the R_1/R_2 radicals is C6 ring (cyclohexyl) and the remaining R_1/R_2 radicals are hydrogens. See col. 8, Example 10. N-cyclopentyl-2-nitro-p-phenylenediamine claimed in Claims 22 and 26 is anticipated by Bil because one skilled in the art would "at once envisage" the compound based on the reference's example and teaching of C5 and C6 cycloalkyls. See MPEP 2131.02. Further, Bil teaches a hair dye composition containing dye, ethanol, ethanolamine, Sodium N-methyl-N-oleoyl-taurate (surfactant), sodium carboxymethylcellulose and water. See col. 5, lines 35-55. The composition of Bil is free of oxidation dye precursors and is formulated to remain in contact with hair for 20 minutes as required by Claims 28 and 29. See col. 5, lines 48-61. With respect to the limitation "wherein the 2-nitro-p-phenylenediamine derivative makes a reddish contribution to the overall color of the keratin fibers" recited in Claims 19 and 38, this property is inherent to N-cyclopentyl-2-nitro-p-phenylenediamine. The Courts have held that a compound and all its properties are inseparable. See *In re Papsech*, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

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Thus, Bil teaches each and every limitation of Claims 19, 21-23, 25, 26, 28-30, 36 and 38.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bil (US 3,632,582) in view of Rose et al. (US 4,900,327).

Bil applied as above. With respect to Claim 27, the Bil reference does not teach additional substantive dye. With respect to Claims 31-34, the Bil reference does not teach the claimed primary and/or secondary intermediates. However, Rose et al. teach hair dye compositions containing a substantive dye used either alone or in combination with other substantive dyes in order to achieve the desired hair color. See col. 3, lines 1-6. The hair dye compositions of Rose et al. may also contain oxidation dye precursors such as primary intermediates (e.g. aromatic amines containing another free or substituted hydroxy or amino moiety in the para or ortho position, diaminopyridine derivatives, 2,4,5,6-tetraaminopyrimidine) and secondary intermediates (couplers) (e.g. m-aminophenol, naphthols, resorcinol) in order to achieve the desired hair color. See col. 3, lines 10-25. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hair dye composition of

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Bil such that to employ additional substantive dyes and/or oxidation dye precursors such as primary and/or secondary intermediates of Rose et al. One having ordinary skill in the art would have been motivated to do this to obtain compositions which would alter the color of hair to a desired degree as suggested by Rose et al.

7. Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bil (US 3,632,582) in view of Grollier et al. (US 4,566,875).

Bil applied as above. With respect to Claim 35, the Bil reference does not teach at least one anionic, cationic and/or nonionic polymer. With respect to Claim 37, the Bil reference does not teach at least one conditioning component. However, Grollier et al. teach using cationic polymers in hair dye compositions "to improve the feel of the hair and to make the hair easier to comb out", i.e. for their hair conditioning properties. See col. 13, lines 18-35. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hair dye composition of Bil such that to employ cationic polymers. One having ordinary skill in the art would have been motivated to do this to obtain compositions having hair conditioning properties such as improved feel and detangling as suggested by Grollier et al.

Conclusion

8. No claim is allowed at this time.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary L. Kunz
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SUPERVISORY PATENT EXAMINER
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3/23/05